

### REMARKS

This Application has been carefully reviewed in light of the Office Action mailed May 8, 2008. At the time of the Office Action, Claims 27-42 were pending in this Application. Claims 27-42 were rejected. Claims 1-26 were previously canceled. Applicants respectfully request reconsideration and favorable action in this case.

#### **Rejections under 35 U.S.C. §103**

Claims 27-33 and 37-42 were rejected under 35 U.S.C. §103(a) as being unpatentable over International Application WO9833343 issued to Marja-Leena Lehmus et al. ("*Lehmus*") in view of U.S. Patent 6,907,239 issued to Timo E. Sivula ("*Sivula*"). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

Claims 34-36 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Lehmus* in view of *Sivula* and further in view of U.S. Patent 6,967,011 issued to Arnaud Capitant ("*Capitant*"). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with

some rational underpinning to support the legal conclusion of obviousness.” *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

The Examiner stated that *Siluva* clearly teaches communicating the evaluated pre-paid account status message from the user identification circuit to the telecommunication device. (Office Action, page 3, first full paragraph). Applicant respectfully disagrees. The user identification device in *Siluva* is the Subscriber Identification module (SIM). (*Siluva*, col. 1, lines 52-55). However, contrary to the Examiner’s assumption, no transfer of an evaluated pre-paid account status from the SIM card to the telecommunication device takes place. Rather, *Siluva* teaches a different approach. According to *Siluva*, to establish a pre-paid service, a user must create an account. This is done by buying a SIM card. (*Siluva*, col. 1, lines 52-55) The user must then call an automatic answering device and provide the automatic answering device with the serial number to establish the account. (*Siluva*, col. 1, lines 56-61) Hence, according to *Siluva* up to this point the SIM card is not even physically involved because the user has to communicate the serial number to the answering machine. *Siluva* leaves it open how the actual debiting of the account is accomplished by merely stating that the account will be debited when telephone calls are made and short messages are sent. (*Siluva*, col. 1, lines 60-61) Nowhere is stated that the SIM card actually receives a pre-paid account status message let alone that this pre-paid account status is evaluated and communicated from the SIM card to the telephone. Rather, *Siluva* teaches that the user must refill the account when the remaining value on the account approaches zero by buying a ticket and calling to a dedicated telephone number. (*Siluva*, col. 1, lines 61-65) Thus again, the SIM card is not involved in this transaction as this transaction is clearly performed manually by a user.

Hence, *Siluva* clearly lacks any disclosure of the above recited limitation. Therefore, the combination of *Lehmus* and *Siluva* cannot render the present independent claim 27 obvious. Independent claim 39 includes similar limitations and therefore should be allowable as well. Applicants respectfully submit that the dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicants respectfully request reconsideration and allowance of the dependent Claims. Applicants reserve the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §103(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.

**Association of Customer Number and Change of Correspondence Address**

Applicants respectfully request that all papers pertaining to the above-captioned patent application be associated with Customer No. **31625**, and direct all correspondence pertaining to this patent application to practitioners at Customer Number **31625**. All telephone calls should be directed to Andreas Grubert at 512.322.2545. A Revocation and Power of Attorney will be submitted shortly.

ATTORNEY DOCKET  
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(2002P12770WOUS)

PATENT APPLICATION  
10/529,031

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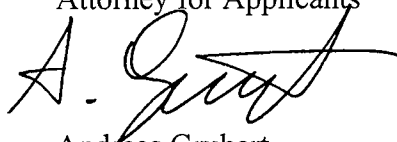
### CONCLUSION

Applicants have now made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of all pending Claims.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2545.

Respectfully submitted,  
BAKER BOTTS L.L.P.  
Attorney for Applicants

A handwritten signature in black ink, appearing to read 'A. Grubert', is written over the typed name.

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Date: September 16, 2008

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